



01-18-06

PR

Docket No.: 06727/100J782-US4  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Tamir Ben-David et al.

Application No.: 10/719,659

Confirmation No.: 2380

Filed: November 20, 2003

Art Unit: N/A

For: SELECTIVE NERVE FIBER STIMULATION  
FOR TREATING HEART CONDITIONS

Examiner: Not Yet Assigned

INFORMATION DISCLOSURE STATEMENT (IDS)

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Information Disclosure Statement is submitted in accordance with 37 C.F.R. 1.97, 1.98, and it is requested that the information set forth in this statement and in the listed documents be considered during the pendency of the above-identified application, and any other application relying on the filing date of the above-identified application or cross-referencing it as a related application.

1. This IDS should be considered, in accordance with 37 C.F.R. 1.97, as it is filed:

(Check one of the boxes A-D)

- A. Within three months of the filing date of the above-identified national application or within three months of the entry into the national stage of the above-identified international application.
- B. before the mailing date of a first office action on the merits, or a first office action after filing a request for continued examination.
- C. after (A) and (B) above, but before final rejection or allowance, and Applicants have made the necessary statement in box "i" below or paid the necessary fee in box "ii" below.

(check one of the boxes "i" and "ii" below:)

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- i. Counsel states that, upon information and belief, each item of information listed herein was either (a) first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this IDS; or (b) was not cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of undersigned after making reasonable inquiry, was not known to any individual designated in 1.56(c) more than three months prior to the filing of this IDS.
    - ii. A check for the fee set forth in 1. 17(p), presently believed to be \$180, is enclosed.
- D. after (A), (B) and (C) above, but before payment of the issue fee: Applicant petitions under 37 C.F.R. 1.97(d) for the consideration of this IDS. Under 37 CFR 1.17(i) a check in the amount of \$180.00 is enclosed. Counsel certifies that, upon information and belief, each item of information listed herein was either (i) cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the IDS; or (ii) was not cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the undersigned after making reasonable inquiry, was not known to any individual designated in 1.56(c) more than three months prior to the filing of this IDS.

2. In accordance with 37 C.F.R. 1.98, this IDS includes a list (e.g., form PTO/SB/08) of all patents, publications, or other information submitted for consideration by the office, either incorporated into this IDS or as an attachment hereto. A copy of each document listed is attached, except as explained below.

(check boxes A, B and/or C and fill in blanks, if appropriate.)

- A. Pursuant to the Notice issued by the United States Patent and Trademark Office dated July 11, 2003 waiving the requirements of 37 C.F.R. § 1.98(a)(2)(i), a copy/copies of the United States Patent on PTO/SB08 is/are not being submitted.
- B. Document(s) \_\_\_\_\_ is (are) deemed substantially cumulative to document(s) \_\_\_\_\_, and, in accordance with 1.98(c), only a copy of each of the latter documents is enclosed.
- C. Certain documents were previously cited by or submitted to the Office in the following prior applications, which are relied upon under 35 U.S.C. 120:

10/205,475, filed July 24, 2002.

Applicant identifies these documents by attaching hereto copies of the forms PTO-892, PTO-1449 and/or PTO/SB/08 from the files of the prior application(s) or a fresh PTO/SB/08 listing these

documents, and request that they be considered and made of record in accordance with 1.98(d). Per 37 CFR 1.98(d), copies of these documents need not be filed in this application.

3. Cite Nos. \_\_\_\_\_ are not in the English language. In accordance with 1.98(c), Applicant states:

- An English translation of each document (or of the pertinent portions thereof), or a copy of each corresponding English-language patent or application, or English-language abstract (or claim) is enclosed.
- The requirement for a concise explanation of the relevance of any foreign language document is satisfied by the attached search report; citation of the documents cited in the search report shall not be construed as an admission that they are or are considered to be, material to patentability of the subject matter claimed herein (See MPEP §609).
- A concise explanation of the relevance of document(s) \_\_\_\_\_ is set forth as follows: [Insert concise explanation of relevance]
- A concise explanation of the relevance of document(s) \_\_\_\_\_ can be found on page(s) \_\_\_\_\_ of the specification.
- A concise explanation of document(s) \_\_\_\_\_ can be found on the attached sheet.

4. No explanation of relevance is necessary for documents in the English language (see reply to Comments 67 in the preamble to the final rules; 1135 OG 13 at 20).

5. Other information being provided for the examiner's consideration follows:

[A/An Office Action, dated November 22, 2006, which issued during the prosecution of United States Application No. 10/461,696.]

6. In accordance with 37 C.F.R. 1.97(g) and (h), the filing of this IDS should not be construed as a representation that a search has been made or that information cited is, or is considered to be, material to patentability as defined in §1.56 (b), or that any cited document listed or attached is (or constitutes) prior art. Unless other-wise indicated, the date of publication indicated for an item is taken from the face of the item and Applicant reserves the right to prove that the date of publication is in fact different.

**CROSS REFERENCE UNDER 37 C.F.R. (1.78 TO RELATED APPLICATIONS**

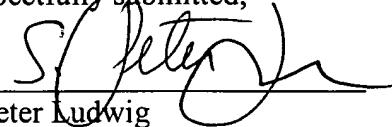
Pursuant to 37 C.F.R. ( 1.78, Applicant notes that the above-identified patent application may be related to the following U.S. Patent Applications:

(1) U.S. Patent Application Serial No \_\_\_\_\_, filed \_\_\_\_\_.

Early and favorable consideration is earnestly solicited.

Dated: January 2006

Respectfully submitted,

By   
S. Peter Ludwig

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Attorneys/Agents For Applicant



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Substitute for form 1449A/B/PTO				Complete If Known	
				Application Number	10/719,659
				Filing Date	November 20, 2003
				First Named Inventor	Tamir Ben-David
				Art Unit	N/A
				Examiner Name	Not Yet Assigned
Sheet	1	of	2	Attorney Docket Number	06727/100J782-US4

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. <sup>1</sup>	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code <sup>2</sup> (if known)			
AA*	US-5,330,507-B1	07-19-1994	Schwartz		
AB*	US-4,649,936-B1	03-17-1987	Ungar		
AC*	US-6,934,583-A1	04-24-2003	Weinberg et al.		
AD*	US-6,907,295-A1	03-13-2003	Gross et al.		
AE*	US-6,668,191	12-23-2003	Boveja		
AF*	US-20040243182-A1	12-02-2004	Cohen et al.		
AG*	US-20040162594	08-19-2004	King		

FOREIGN PATENT DOCUMENTS					
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Country Code <sup>3</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known)			
					T <sup>6</sup>

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup>Applicant's unique citation designation number (optional). <sup>2</sup>See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup>Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup>For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup>Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup>Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS					
Examiner Initials	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.			T <sup>2</sup>
CA**	U.S. Provisional Patent Application No. 60/263,834, entitled "Selective Blocking of Nerve Fibers", filed January 25, 2001.				
CB**	Ungar, I. J., et al. "Generation of Unidirectionally Propagating Action Potentials Using a Monopolar Electrode Cuff", Annals of Biomedical Engineering, Vol. 14, pp. 437-450, 1986.				
CC**	Sweeney, James D., et al. "An Asymmetric Two Electrode Cuff for Generation of Unidirectionally Propagated Action Potentials", IEEE Transactions on Biomedical Engineering, Vol. BME-33, No. 6, June 1986.				
CD**	Naples, Gregory G., et al. "A Spiral Nerve Cuff Electrode for Peripheral Nerve Stimulation", IEEE Transactions on Biomedical Engineering, Vol. 35, No. 11, November 1998, pp. 905-916				
CE**	Sweeney, James D., et al. "A Nerve Cuff Technique for Selective Excitation of Peripheral Nerve Trunk Regions", IEEE Transactions on Biomedical Engineering, Vol. 37, No. 7, July 1990.				
CF**	Van Den Honert, et al. "Generation of Unidirectionally Propagated Action Potentials in a Peripheral Nerve By Brief Stimuli", Science magazine, Vol. 206, December 14, 1979, pp. 1311-1312.				
CG**	U.S. Patent Application No.: 09/824,682 entitled "Method and Apparatus for Selective Control of Nerve Fibers" filed April 4, 2001				
CH**	Cortese, J.F. "Vagus Nerve Stimulation for Control of Intractable Epileptic Seizures" available at <a href="http://www.science.wayne.edu/~bio340/StudentPages/cortese/">http://www.science.wayne.edu/~bio340/StudentPages/cortese/</a> , May 31, 2001				
CI**	Website: <a href="http://www.bcm.tmc.edu/neurol/struct/epilep/vagus.html">http://www.bcm.tmc.edu/neurol/struct/epilep/vagus.html</a> , May 31, 2001				
CJ**	Baratta, et al. "Orderly stimulation of Skeletal Muscle Motor Units with Tripolar Nerve Cuff Electrode", IEEE Transactions of Biomedical Engineering, Vol. 36, no. 8, August 1989, pp.836-				

Examiner Signature		Date Considered
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Substitute for form 1449A/B/PTO				<b>Complete if Known</b>	
				Application Number	10/719,659
				Filing Date	November 20, 2003
				First Named Inventor	Tamir Ben-David
				Art Unit	N/A
				Examiner Name	Not Yet Assigned
Sheet	2	of	2	Attorney Docket Number	06727/100J782-US4

		843	
	CK**	Fitzpatrick, et al. "A Nerve Cuff Design for the Selective Activation and Blocking of Myelinated Nerve Fibres", Annual Conference of the IEEE Engineering in Medicine and Biology Society, Vol. 13, No. 2, 1991.	
	CL**	PATENT ABSTRACTS OF JAPAN; vol. 1998, no. 09, 31 July 1998 & JP 10 096577 A (Matsushita Refrig Co Ltd), 14 April 1998.	
	CM**	Devor, M. "Pain Networks", Handbook of Brain Theory and Neural Networks", Ed. M.A. Arbib, MIT Press, page. 698, 1998.	
	CN**	Rijkhoff, N.J.M., et al. "Orderly recruitment of motoneurons in an acute rabbit model", 20th Annual International Conference of the IEEE Engineering in Medicine and Biology Society, Vol. 20, No. 5, 1998, pp. 2564-2565	
	CO**	Van Den Honert, et al. "A Technique for Collision Block of Peripheral Nerve: Frequency Dependence", IEEE Transactions of Biomedical Engineering, Vol. BME-28, No. 5, May 1981, pp. 379-382	

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup>Applicant's unique citation designation number (optional). <sup>2</sup>Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature		Date Considered	
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Application No. (if known): 10/719,659

Attorney Docket No.: 06727/100J782-US4

## **Certificate of Express Mailing Under 37 CFR 1.10**

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Alexandria, VA 22313-1450

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